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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,406	04/08/2005	Georg Frohlich	P04,0353	6881
26574	7590	06/30/2005	EXAMINER	
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			MAI, THIEN T	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/507,406	Applicant(s) FROHLICH ET AL.	
	Examiner Thien T. Mai	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The Oath/Declaration filed by applicants in April 2005 has been considered. The examiner respectfully is taking into considerations all of the claims presented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 18, 31-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Teraura.

Regarding claim 18, Teraura discloses a method for production of a printed document (13) with a unique identifier such as confirmation information based on character or graphic data sent from external apparatus, comprising the steps of:

- applying a data medium (14) for said unique identifier on a recording medium such as a paper sheet before a document printing production event; said data medium is an RFID transponder, known in the art for having storage capability in memory chip and being electronically written without contact, so that in the course of document production event, data is written without contact onto the RFID transponder. (See Abstract.)

Teraura additionally discloses the data sent from a computer, inherently known to have at least a program for data transferring, and the data in the form of character text or graphics together make up the confirmation information that is stored in the RFID transponder file, inherently known to be located in embedded memory, and printed on the RFID paper sheet. (Abstract.)

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Regarding claims 31-35, see discussion regarding claim 18.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim(s) 19, 27 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (JP02002337426A) in view of Laussermair (6137967) and Nelson (6542622).

Regarding claim 19, Teraura discloses all limitations set forth in this claim as discussed above except the limitation wherein the file is being used to check validity of the printed document.

Laussermair discloses that “sequence number check for registration and tracking of documents. For that purpose, the vision system may read document identification data such as numbers printed on the documents on predetermined locations. The vision system compares these data with externally provided data (number sequences). The vision system may also detect any bar code printed on the documents and use such information for tracking”. (Col 5 lines 17-25). Accordingly, the method of Laussermair includes the fact that the document is being captured/read and compared with the data from external source, which inherently known to have a file.

Regarding claim 27, Teraura and Laussermair disclose all limitations set forth in this claim as discussed above except for the method wherein the erroneous document is separated out and reprinted if faulty printing, faulty identification, and erroneous write of data medium do occur. Nelson discloses the document is reprinted when found to have poor print quality and erroneous (Col 3 lines 50-57.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the method of Laussermair and Nelson for ensuring and verification of the contents on the

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printed document being printed properly before programming information into the data medium, thus saving the production time and resources.

4. Claim(s) 20-22 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (JP02002337426A) in view of Pagnol (6483426).

Regarding claim 20, Teraura discloses all limitations set forth in this claim as discussed above except the data medium comprises an unchangeable identifier number in an electronic region. Pagnol (6483426) discloses such concept is known when a plurality of transponders are involved in an operation. (Col. 1 lines 36-40, Col. 4 lines 50-53.) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the method of Pagnol for further improvement the security of the document that requires additional identification of the transponder.

Regarding claim 21, see discussion regarding claims 18 and 20.

Regarding claim 22, see discussion regarding claims 18 and 20.

5. Claim(s) 23, 25 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (JP02002337426A) in view of Ahlstrom (6222452) and Laussermair (6137967).

Regarding claim 23, Teraura discloses the identifier number printed in plain text is identical to the RFID number stored in the embedded RFID tag, but does not disclose whether it is identical to an identifier number stored in an optical barcode. Ahlstrom discloses that such method is known in the art especially in the airline industry for making luggage identification tags. (Col 7 lines 1-19, Figure 1.)

Regarding claim 25, Teraura, Laussermair, Alstrom effectively disclose all limitations set forth in this claim in regard to verification of printed document and printing of identification document are discussed in claims 18, 19, and 23.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use the method of Teraura, Ahlstrom, and Laussermair for more effectiveness in verification/validation of printed document and in identifying the objects of interests.

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6. Claim(s) 24 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (JP02002337426A) in view of Kelly (20030085286).

Regarding claim 24, Teraura discloses all limitations set forth in this claim as discussed above except the unique identifiers of a person being stored on the document and in the file. Teraura does not clearly disclose the information content in the file and on the printed file whether or not including personal information. However, Kelly discloses that personal information can be stored in the memory of a secure document such as secure card. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the method of Kelly for further identifying person(s) associated or related to the content information of the document.

7. Claim(s) 26 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (JP02002337426A) in view of Mizoguchi (20020043557).

Regarding claim 26, Teraura discloses all limitations set forth in this claim as discussed above except the information in the data medium is encrypted. Mizoguchi discloses the method of embedding encrypted data into memory cards is known in the art. (Specification par. 0014.) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the method suggested by Mizoguchi to further protect the secure data stored in the data medium and prevent it from being read.

8. Claim(s) 28 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (JP02002337426A) in view of Jones (20030178495).

Regarding claim 28, Teraura discloses all limitations set forth in this claim as discussed above except the electronic writing in the data medium to occur after the recording medium has left the print device. Jones discloses "[0063] A smart ID document results once the integrated circuitry module is secured in a cavity of an ID document (FIG. 2C). A smart card module can be optionally programmed to store relevant information such as information printed on the document, biometric information, account

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information, cryptographic hashes or other algorithmic representation of data, passwords, etc. One programmer example is a computerized smart card Personalizer, e.g., as provided by Muhlbauer of Germany, which enters commands or data into the smart card module. Other programmers are provided, e.g., from Hitachi and Atmel, among many others. Information stored in the smart card circuitry is optionally cross-correlated with information printed on the smart card. This cross-correlation can be checked to verify authenticity of the document or stored information. Or if a digital watermark is provided on the document, a watermark payload can be cross-correlated with information stored in the smart card's memory circuitry. A cross-correlation of the watermark information and the module's stored information can be analyzed to determine authenticity of the identification document.” (Specification par.0063.) Accordingly, a document of Jones capable of storing information can be programmed when the document is already printed and thus satisfy the limitation of this claim. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement Jones’ method to ensure the document is properly printed before information is written to the data medium therefor minimize the security risk of stolen information in programmed document that is unprinted and discarded.

9. Claim(s) 29 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (JP02002337426A) in view of Tame (20040026502).

Regarding claim 29, Teraura discloses all limitations set forth in this claim as discussed above except the information is stored in the data medium at the monitoring/detection point where the document is detected. Tame discloses that the document can be detected by scanning before information is written to the document referred to as smart card. (See Specification par. 0055.) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the method suggested by Tame for document verification before written secure information in the data medium.

10. Claim(s) 30 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (JP02002337426A) in view of Wallen (20050038821).

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Regarding claim 30, Teraura discloses all limitations set forth in this claim as discussed above except that additional data, when detected from the document, is stored in the data medium and a central tracking databank at the monitoring point. Wallen discloses that the method of storing information data related to each other in the database is known in the art. (Specification par. 0061.) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the method of Wallen to keep track and store, for later analysis for example, all of the data being related or added to the document.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Thien T Mai
Examiner
Art Unit 2876

June 23, 2005



**THIEN M. LE
PRIMARY EXAMINER**